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In re Application of SIM et al
U.S. Application No.: 09/763,338
Int. Application No.: PCT/AU00/00937
Int. Filing Date: 07 August 2000
Priority Date: 06 August 1999
Attorney Docket No.: 4670/1
For: NETWORK RESOURCE MONITORING AND
MEASUREMENT SYSTEM AND METHOD

DECISION

This is in response to applicant's "Petition Under 37 C.F.R. 1.47(b) in Support of Filing on Behalf of Non-Signing Inventors" filed 17 April 2002.

BACKGROUND

On 07 August 2000, applicant filed international application PCT/AU00/00937, which claimed priority of an earlier Australia application filed 06 August 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 15 February 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 06 February 2002.

On 16 February 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 17 April 2002, applicant filed the present petition under 37 CFR 1.47(b). The petition states that none of the six joint inventors can be found after diligent effort.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

In the present case, the petition states that a diligent effort was made to locate the missing inventors. However, applicant has provided no specific details of any efforts to contact the inventors. Applicant should provide a declaration of facts signed by the person having firsthand knowledge of the purported attempts to find the inventors. Documentary evidence of the purported attempts should also be provided.

With regard to item (3) above, the petition does not state the last known addresses of the nonsigning inventors.

With regard to item (4) above, when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. See MPEP 324. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO. In the present case, applicant has

provided a copy of an assignment agreement establishing a chain of title from the inventors to the assignee Red Sheriff, Limited.

MPEP 409.03(b) states in relevant part,

A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation.

In the present case, the petition is accompanied by a declaration signed by attorney/agent James Woods, who is registered to practice before the USPTO. The petition is accompanied by a statement signed by Mr. Woods which states that he is authorized to sign on behalf of the assignee Red Sheriff, Limited.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, item (A) applies. The petition is accompanied by a copy of an assignment agreement which indicates that the invention has been assigned to the 37 CFR 1.47(b) applicant Red Sheriff, Limited.

With regard to item (6) above, applicant has made an adequate showing that the filing of the application under 37 CFR 1.47(b) is necessary to preserve the rights of the parties.

CONCLUSION

Because applicant has failed to satisfy items (2) and (3) above, the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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